REMARKS

Claims 135 remain in this application. The originally filed application contained two claims numbered 65. The second claim number 65 has been canceled.

I. CLAIM REJECTIONS – 35 USC § 102

A. Examiner's Statements

The examiner rejected claims 1-135 under 35 U.S.C. § 102(e) as being anticipated by Nguyen et al. (U.S. Patent No. 6,571,887) or alternatively as being anticipated by Larsen et al. (U.S. Patent No. 6,763,902).

B. Law

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.[1] The identical invention must be shown in as complete detail as is contained in the ... claim.[2] To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient."[3] Thus, the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish inherency of that result or characteristic.[4] In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.[5] In addition to disclosing every claim limitation, an anticipatory prior art reference must enable the practice of the invention and describe it sufficiently to have placed it in the possession of a person of ordinary skill in the field of the invention.[6]

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[1] *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987).

[2] *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

[3] *In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999).

[4] *In re Rijckaert*, 9 F.3d 1531, 1534, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993).

[5] *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

[6] *In re Paulsen*, 30 F.3d 1475, 1478-79 (Fed. Cir. 1994).

C. Claims 1 - 135

Claims 1-135 of the present application require first and second nozzle receptacles that are formed by a bit body. The nozzle receptacles, in turn, receive nozzles for controlling fluid flow from the bit body. Both Nguyen et al. and Larsen et al., however, teach nozzle retention bodies (130) for attachment to the bit body (102). The nozzle retention bodies also receive nozzles (210) but are separate from the bit body. In some embodiments, the nozzle retention bodies may even be selectively positioned relative to the bit body for a specific fluid path before final attachment to the bit body by welding or some other means. The nozzle receptacles of claims 1-135, however, are formed by and thus integral with the bit body. Any positioning of the direction of the fluid path from the claimed nozzle receptacles must be performed when manufacturing the bit body itself. Thus, neither Nguyen et al. nor Larsen et al. disclose first and second nozzle receptacles formed by a bit body as required by claims 1-135. The applicants therefore respectfully submit that the rejection is unsupported by the art and request that the examiner withdraw the rejection.

II. NON-STATUTORY DOUBLE PATENTING

The examiner provisionally rejects claims 1, 17, 33, 55-57, 65, 66, 76, 77, 88, and 89 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 5, 7, 8, 17, 104-106, 110, 111, 116, 125, 126, 128, 129, 131, and 132 of copending U.S. Patent Application No. 10/1816,542 ("the '542 Application").

The applicants acknowledge the provisional rejection and, should the claims at issue in the '542 Application issue, the applicants will take the action deemed appropriate or required at that time.

III. STATEMENT REGARDING CLAIMS

The applicants comment on the allowability of the claims by addressing the examiner's comments in this paper as well as previously during the prosecution of this application. By doing so, the applicants are in no way limiting their ability to argue additional points of novelty regarding the claims at a later date.

CONCLUSION

The applicants respectfully request reconsideration the pending claims and that a timely Notice of Allowance be issued in this case. If the examiner feels that a telephone conference would expedite the resolution of this case, he is respectfully requested to contact the undersigned.

In the course of the foregoing discussions, the applicants may have at times referred to claim limitations in shorthand fashion, or may have focused on a particular claim element. This discussion should not be interpreted to mean that the other limitations can be ignored or dismissed. The claims must be viewed as a whole, and each limitation of the claims must be considered when determining the patentability of the claims. There may also be other distinctions between the claims and the prior art that have yet to be raised, but that may be raised in the future.

Unless the applicants have specifically stated that an amendment was made to distinguish the prior art, it was the intent of the amendment to further clarify and better define the claimed invention and the amendment was not for the purpose of patentability. Further, although the applicants may have amended certain claims, the applicants have not abandoned their pursuit of obtaining the allowance of these claims as originally filed and reserve, without prejudice, the right to pursue these claims in a continuing application.

If any fees are inadvertently omitted or if any additional fees are required or have been overpaid, please appropriately charge or credit those fees to Conley Rose, P.C. Deposit Account Number 03-2769 (ref. 1030-23200) of Conley Rose, P.C., Houston, Texas.

Respectfully submitted,
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